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EXAMINER
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FELTEN, DANIEL S

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/238,995  
Filing Date: January 28, 1999  
Appellant(s): KAWAN, JOSEPH C.

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John M. Harrington  
(Reg. No. 25, 292)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 24, 2008 appealing from the Office action mailed October 31, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Applicants previously appealed a final rejection and filed an Appeal Brief on October 3, 2003, whereupon on September 1, 2006 in lieu of a Reply Brief the Examiner withdrew the finality of the rejection and issued a non-final office action. There are no other appeals or interferences related to this case.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,221,838	GUTMAN et al	6-1993
5,563,393	COUTTS	10-1996
5,748,737	DAGGER	5-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74, 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Gutman et al (US 5221, 838) in view of Dagger (US 5,748,737) and Coutts (US 5,563,393).

Gutman shows a method of contact less interfacing for a finance card which allows a user to establish a physical contact communication interface between a financial card (22) and a

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hand-held computing device (electronic wallet) for accessing a financial card application on the of the financial card (see col. 5, lines 44-65), *As in claims 1 and 63*

--identify information and transaction information on the hand-held computing device (see col. 5, lines 57-59; and col. 7, lines 66 to col. 8, lines 2), *as in claims 1 and 63*

--initiate a contact less bi-directional communication interface via the hand-held computing device between the smart card application and a self-service transaction terminal of an on-line system of a financial institution (see fig. 1, col. 3, lines 46-68; and col. 4, lines 36-54), *as in claim 1 and 63*

--verify the financial card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device and the self-service transaction terminal (see col. 7, lines 66 to col. 8, line 2), *as in claims 1, 63 and 81* and

--communicate the transaction information entered by the user on the hand-held computing device to the self-service transaction terminal of the on-line system via the contact less communication interface (see figs. 5B-5E, col. 12, line 64+; and col. 14, lines 17+), *as in claims 1, 63 and 81*

Gutman discloses that the financial card is a magnetic card that is used to exchange information, but fails to disclose that the financial card is a smart card. Dagger teaches that electronic purse systems have generally adopted the smart card for contact retail payments and non-contact cards for transportation payments such as tolls (see Dagger, col. 1, lines 57-67). Dagger also discloses Gutman failing to use the smart card (see col. 6, lines 36+). It would have been obvious for one of ordinary skill in the art to modify/substitute the smart card of Dagger for

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the magnetic card of Gutman to provide the latest electronic wallet technology to allow existing infrastructures to accept new digital card transactions, provide digital card storage, reduce fraud, etc., as enunciated in Dagger (see Dagger, col. 8, lines 3-43). Thus such modification would have been an obvious expedient to one of ordinary skill in the art.

Coutts discloses an interface device 12, that uses bi-directional communication between a PCMCIA card and a ATM via a interface device (see Coutts, Abstract, column 2, line 54 to column 3, line 23). It would have been obvious for an artisan of ordinary skill at the time to the invention to recognize that Gutman would have sought to modify it's invention with the PCMCIA card as provided in Coutts because an artisan would have desired the latest card technology to make secure financial transactions. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

*As in claims 2 and 64*, wherein the contact-less communication interface further comprises an infrared communication interface (see Gutman, col. 4, lines 36-54).

*As in claims 3 and 65*, wherein the contact less communication interface further comprises a wireless communication interface(see Gutman, col. 4, lines 36-54).

*As in claim 4 and 66*, further comprises a radio frequency communications interface(see Gutman, col. 4, lines 36-54).

As in claim 5, wherein the wireless communication interface(see Gutman, col. 4, lines 36-54)

*Re in claim 6*, wherein the radio frequency communication interface further comprises a proximity communication interface (see Gutman, col. 4, lines 35-55) .

*As in claim 8*, wherein the financial institution further comprises a bank (see Gutman, col. 7, lines 50-53).

*As in claim 9*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communications interface through a contact less communication transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claim 11*, wherein allowing the user to initiate the contact less communication interface between the smart card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through an ignored transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claims 12 and 69*, wherein the self-service transaction terminal further comprises an automated teller machine (see Dagger, col. 20, lines 11-19),

*As in claim 13 and 70*, wherein the self-service transaction terminal further comprises a personal computer (see Gutman, col. 9, lines 37-44).

*As in claims 14 and 71*, wherein the self-service transaction terminal further comprises a telephone (304) (see Gutman, fig. 4, col. 10, lines 66 to col. 11, line 50).

*As in claims 15*, wherein the self-service transaction terminal further comprises a wireless telephone (see “pager,” col. 11, lines 9+).

*As in claim 16*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a wireless transceiver of the terminal (see “pager,” col. 11, lines 9+).

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*As in claim 17*, wherein the Wireless transceiver further comprises a radio frequency transceiver of the terminal (see col. 4, lines 36-54).

*As in claim 22*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a proximity transceiver of the terminal (see Gutman, col. 4, lines 35-55),

*As in claim 27*, wherein allowing the user to initiate the contact less communication further comprises allowing the user to initiate the contact less communication between the contact less communication transceiver of the self-service transaction terminal and a contact less communication transceiver of the hand-held computing device comprising a personal data assistant (electronic wallet) (see col. 9, lines 10-26).

*As in claim 33*, wherein the personal data assistant further comprises an electronic purse or wallet (see Abstract; also col. 3, lines 46+).

*As in claim 39*, wherein verifying the smart card further comprises verifying the smart card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device comprising a personal data assistant and the self-service transaction terminal(see col. 7, lines 66 to col. 8, line 2).

*As in claim 42*, wherein verifying the smart card further comprises verifying the authenticity of the financial card (see col. 7, lines 66 to col. 8, line 2).



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*As in claim 43*, wherein verifying the financial card further comprises checking security information for the user.

*As in claim 44*, wherein checking security information further comprises receiving security information for the user (see col. 7, lines 66 to col. 8, line 2).

*As in claim 45*, wherein receiving security information further comprises receiving a PIN number (e.g. password) for the user (see col. 7, line 66 to col. 8, line 2).

*As in claim 47*, wherein receiving security information further comprises receiving the security information on an input/output device (see col. 7, lines 66 to col. 8, line 2)

*As in claim 48 and 73*, wherein receiving the security information further comprises receiving the security information through an input output device of the hand-held computing device comprising a personal data assistant (see col. 9, lines 10-26).

*As in claim 49 and 74*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

*As in claim 50*, wherein receiving the security information further comprises receiving the information through the input/output device of a terminal (see col. 7, line 66 to col. 8, line 2)

*As in claims 55*, wherein allowing the user to enter the transaction information further comprises receiving the information through an input/output device (see col. 7, line 66 to col. 8, line 2)

*As in claim 56*, wherein receiving the information further comprises receiving the information through the input/output device of the hand-held computing device comprising a personal data assistant (see col. 7, line 66 to col. 8, line 2)

*As in claim 57*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

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*As in claim 58*, wherein receiving the information further comprises receiving the information through the input output device of a terminal(see col. 7, line 66 to col. 8, line 2)

*As in claim 72*, The system of claim 63, wherein the on-line system comprises a bank host on-line system (see Gutman, col. 7, lines 50-53).

*As in claim 75*, wherein the accessing of the smart card application comprises executing the smart card application (see Dagger, col. 12, lines 1-8).

*As in claim 80*, wherein the accessing of the smart card application comprises loading the smart card application (see Gutman, col. 7, lines 50-53)

Re claim 46: computer systems receiving biometric information from a user (e.g., fingerprint, retina scan etc.) is notoriously old and well known for retrieving information that is uniquely and readily available from the user and is matched against the system's database to provide access similar to that of other well known techniques (e.g. PIN, password, etc.). Thus Official Notice is taken of receiving biometric information because one of ordinary skill in the art would have recognized biometric data as an obvious alternative to the PIN and/or password disclosed in Gutman and Dagger to access their systems and to perform various transactions. Thus an artisan would have recognized the fact that to provide a fingerprint or a retina scan would substitute for a PIN number or password in the event that the PIN number and/or password was forgotten or lost. Thus the such a modification would be well within the ordinary skill of the art as well as being an obvious extension to the teachings of Gutman and Hsu to continue to allow users to access their systems without a PIN and/or password per se.

### **(10) Response to Argument**

The applicant asserts that Gutman teaches nothing more than a magnetic stripe card/reader writer of and electronic wallet that reads and writes magnetic data on a magnetic stripe and that a magnetic stripe is incapable of having a bi-directional interface with a handheld computing device. Moreover, the applicant simplistically asserts that the logical conclusion that examiner has made is analogous of one reading from and writing to a piece of paper. The examiner disagrees with this for the following reason(s): The applicant provides an analogy by which only one source writes into and reads from the financial card via the electronic wallet. However, the financial card similarly to applicant's smart card, provides bi-directional communication via a means for indicating reading and/or writing to the user (see column 5, line 44 to column 6, lines 7-9) and for receiving information from and providing to the financial card where the electronic wallet is a wireless conduit for financial transactions for the financial card (see column 8, lines 43+; and see figures 5A-D, column 12, lines 33 to column 15, line 41). The deficiencies of Gutman have been previously mentioned in the 35 USC 103 rejection mailed May 18, 2007. In the rejection it indicates how Gutman fails to teach a smart card per se, and how Dagger discloses a electronic wallet which can use both a smart card and a magnetic card to make various financial transactions (see figure 2A, column 10, line 45 to column 11, line 52; and column 12 line 1-41) where the financial advantages of the smart card are also disclosed (see column 12, lines 1+). It is reiterated that it would have been obvious for one of ordinary skill in the art at the time of Gutman to recognized the advantages of the micromodules used in smart cards to satisfy customers needs for convenience, security; payee needs for faster, safer more

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cost-effective operations as enunciated in Dagger (see column 9, line 63+); and to provide the latest electronic wallet technology to allow existing infrastructures to accept new digital transactions, provide digital card storage, fraud protection, etc., as enunciated in Dagger (see Dagger, column 8, lines 3-43).

It is also reiterated that Coutts was used to show that the art teaches bidirectional communication between a PCMCIA card and a ATM via an interface device (see Coutts, Abstract, column 2, lines 54 to column 3, line 23) and that it would have been obvious for Gutman to have sought to modify itself to perform bi-directional communication as disclosed in Coutts because Gutman would have sought the latest financial card technology to make secure transactions. Thus it is submitted that those in the art would have recognized applying the ability to perform bi-directional communication from Coutts would have yielded an improvement to Gutman that was predictable and known within the art.

It should also be addressed that the applicant's argument implies that the examiner's conclusion of obviousness is based upon improper hindsight reasoning; however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Daniel S Felten/

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